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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,693	09/22/2003	Dennis Brave	BRAVE KOCH - FILE	9241
4988	7590	05/19/2006	EXAMINER	
ALFRED M. WALKER 225 OLD COUNTRY ROAD MELVILLE, NY 11747-2712			STOKES, CANDICE CAPRI	
			ART UNIT	PAPER NUMBER
			3732	
DATE MAILED: 05/19/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/667,693

Applicant(s)

BRAVE ET AL.

Examiner

Candice C. Stokes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21-26 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>05/02/06</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of claims 1-16 and 21-27 in the reply filed on 3/08/06 is acknowledged.

Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected holder and organizer for endodontic files, there being no allowable generic or linking claim.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3-5 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "said opening" in line 2. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1) Claims 1,6, and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Manzoli (USPN 6,302,691). Manzoli discloses a self centering endodontic file (12) comprising: a shank (14); a tapered working portion (16) of said shank (14) terminating in a non cutting tip (the tip of the file is not configured to be self-tapping as best shown in Figure 1 its is only tapered to fit into the root canal of the tooth) at a distal end of said shank (14); a non-cutting governor collar (10) formed on said shank (14) adjacent to and distinct from said tapered working portion (16) of said shank (14), said collar (10) having a diameter at least as large as the largest diameter of said tapered working portion and, said governor collar (10) being adapted to contact an entrance wall of a root canal of a tooth in which said file is to be used in order to help stabilize said file. This also anticipates claim 14. Further to claim 14, the collar (10) acts as a

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stop (see column 3, line 51) therefore, when the endodontic file (12) is within a root canal it is inherently in contact with the sides of the opening of the root canal and remains in contact with the sides even when rotating the endodontic file (12). As to claim 6, the collar (10) as shown in Figure 1 has a circular cross section. Regarding claim 15, the non-cutting tip of the endodontic file (12) also remains in contact with the sidewall of the root canal during cutting . It is inherent that an endodontic file must be placed along the sidewall of the root canal during use in order to file the sides of the root canal.

2) Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Riitano et al (USPN 6,746,245). Riitano et al disclose a set of endodontic files for treating and cleaning root canals of a tooth comprising: a set of three files (see Figure 16A), a first orifice enlarging file (200a) of said set of three files initially enlarging the root canal orifice of a root canal, a second cleaning file (200b) of said set of three files cleaning the interior of a root canal to a pre-determined working length of the root canal and, a third shaping and finishing file (200c) of said set of three files applying a shaping and finishing to the root canal to said pre-determined working length.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manzoli.

Manzoli discloses the claimed invention except for the length of the collar being in the range of 1 to 2 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the collar having a length within any range sized to be used in a patient's mouth, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. As to claim 3, the collar (10) is adapted to or capable of contacting the wall of the opening of the root canal.

2) Claims 4-5,7-8, 10-11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manzoli in view of Johnson (USPN 4,894,011). As to claims 4 and 7 Manzoli discloses the claimed invention except for the shank having a reduced collar on a side of the collar away from the working portion of the shank. Johnson teaches a reduced diameter on a side of the collar (24). The reduced diameter is created by the tapered portion of collar (24), as best seen in Figure 2. Further to claim 16, collar (24) has a receptacle (24A) behind it. The portion of the claim that recites "to receive debris" is a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from

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the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It would have been an obvious matter of design choice to provide a reduced diameter on the side of the collar, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 5,8, and 10-11, Manzoli teaches the diameter of collar (10) is greater than the largest diameter (as measured from the center of the file to the sides of the working portion) of the working portion (16). This also reads on claim 10. Also to claim 8, the collar (10) has an axis parallel to an axis of the file (12), this axis being the axis extending from the top of the handle of the file (12) to the bottom of the non-cutting tip. Finally to claim 11, the collar (10) is cylindrical.

3) Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manzoli in view of Senia (USPN 4,850,867). Manzoli discloses the claimed invention except for the file including an axially extending facet. Senia teaches facet (18) as shown in Figure 3. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the facet as taught by Senia into the endodontic file disclosed by Manzoli in order to provide a means for debris to be removed from the collection region while the file is being used.

4) Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manzoli in view of Johnson as applied to claim 7 above, and further in view of Riitano et al (USPN 6,746,245). Manzoli and Johnson teach the claimed invention except for the collar being tilted. Riitano et al teaches an endodontic file (134a) with a tilted collar (140) as best seen in Figures 14A and 14B. It would have been obvious to one having ordinary skill in the art at the



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time the invention was made to incorporate a tilted collar as taught by Riitano et al in order to allow for use of the endodontic file as taught by Manzoli and Johnson at an angle within the root canal for easier filing of the side walls.

5) Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riitano et al in view of McSpadden (USPN 6,293,794). Riitano et al disclose the claimed invention except for the endodontic file having indicia provided on the top proximal surface of each file. McSpadden teaches an endodontic file set wherein each of the files has indicia (32) on the top proximal surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate indicia as taught by McSpadden onto the surface of the file disclosed by Riitano et al in order to provide a means for identifying each file and distinguishing between the different files during use.

6) Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riitano et al. Riitano et al disclose the claimed invention except for each of the three endodontic files having a predetermined taper of specified lengths and the length of the active cutting regions within the specified ranges. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the predetermined taper any value since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the length of the active cutting regions within any ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.



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*Allowable Subject Matter*



Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Stokes whose telephone number is (571) 272-4714. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Candice C. Stokes  
  
PATRICIA BIANCO  
PRIMARY EXAMINER  
5/15/06